

**PRE-APPEAL BRIEF REQUEST FOR
REVIEW**

Docket Number 042933 / 302191

(filed with the Notice of Appeal)

Application Number: 10/085,937

Filed: February 28, 2002

First Named Inventor: Petri Hyypa

Art Unit: 4374

Examiner: Doan, Phuoc Huu

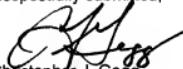
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages are provided.

Respectfully submitted,



Christopher J. Gegg
Registration No. 50,857

Date January 7, 2008

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES
PATENT & TRADEMARK OFFICE ON JANUARY 7, 2008.

Attachment: Reasons for Requesting Pre-Appeal Brief Request for Review

The final Office Action of September 5, 2007, rejects Claims 1, 21, and 26 under 35 U.S.C. § 112, first paragraph, and rejects all of pending Claims 1, 5-24, and 26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0037312 to Gray et al. (“the Gray publication”).

I. Claims 1, 21, and 26 Comply with the Written Description Requirement

Claims 1, 21, and 26 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicant submits that all of the pending claims are fully supported by the application as originally filed, including the amendments made to Claims 1, 21, and 26. The final Office Action states that the amendments to Claims 1, 21, and 26 are “not supported by [the] original specification.” Applicant respectfully contests this assertion. The Advisory Action states “That claim limitation a management entity independent of was not supported by original specification. Therefore, it make a new subject matter which is using the wording such a independent of to make a change the scope of claim invention. Which is mean a independent of the merchant entity?, if so, please show on the specification. This is not refers to a management entity.” Applicant contests this assertion. Further, the Advisory Action states “That claim limitation of a credit card issuer was not supported by original specification.” Applicant also contests this assertion.

As a background for understanding the following remarks, please note that the specification also refers to a management entity as a service provider and a transaction management entity. *See, e.g.,* p. 7, II. 1-5.

With respect to the recited limitation of Claim 1 of “receiving at the user equipment control information from a management entity independent of the merchant entity,” Applicant cites, for example, to page 19, line 1 thru page 20, line 14, which describe *inter alia* that “a merchant entity shall be understood to be a reference to any organization from which the user may purchase goods and/or services.” By comparison, Applicant cites, for example, to page 7, lines 1-5, which describe that a management entity (i.e., “a transaction management service provider entity”) controls any modification operation of the transaction mechanism that may be used by the mobile user equipment. The two entities are described separately and having separate functions. And Applicant submits that the specification as originally filed describes the two entities having separate communications with the user equipment, i.e., the merchant entity communicates with the user equipment according to a transaction mechanism to permit a user to purchase goods and/or services using the user equipment, and the management entity communicates with the user equipment to obtain and/or update a transaction mechanism used by the user

equipment to communicate with the merchant entity. That is, the user equipment can receive control information from the management entity independent of the merchant entity. The claimed invention does not require the merchant entity for receipt of user equipment control information from a management entity. Accordingly, Applicant submits that a management entity (i.e., a service provider), such as a credit card issuer described below with regard to Claims 21 and 26, is an entity independent of a merchant entity and that independent operation of both (i.e., operation of one entity independent of the other) is fully supported by the application as filed as would have been understood by one of ordinary skill in the art at the time the application was filed. While the specific phrase “independent of” may not appear in the application as filed, the subject matter of the claimed invention is fully supported by the disclosure of the application as filed. Applicant notes that the remark in the Advisory Action “There is not refers to a management entity” may not be fully appreciating that the original specification refers to the management entity by several terms, including a service provider, a transaction management entity, and a transaction management service provider entity. Accordingly, Applicant submits that the claim limitation “independent of the merchant entity” is supported by the original specification.

With respect to the recited limitation of Claim 21 of “a transaction service entity of a credit card issuer adapted to generate control information to be transported to the user equipment” and the recited limitation of Claim 26 of “receiving at the user equipment control information from a management entity of a credit card issuer,” Applicant cites, for example, to page 10, lines 27-32, which recite “if the service provider is a credit card issuer the issuer may wish to transmit new security settings or credit limit to the dynamic template 24. To implement this a setup message may be generated by the setup block 29 of the management function of the service provider.” That is, the application as original filed describes that the service provider may be a credit card issuer and further that the credit card issuer may transmit user equipment control information (new security settings or credit limit). Accordingly, Applicant submits that the claim limitation “of a credit card issuer” is supported by the original specification.

In view of the remarks above, Applicant submits that the § 112, first paragraph rejections are traversed. Applicant respectfully requests that the rejections be withdrawn and that the finality of the Office Action also be withdrawn with respect to this issue for lack of presentation of a *prima facie* § 112 rejection upon which finality of the pending Office Action may be supported.

II. Claims 1, 5-24, and 26 Are Not Anticipated by the Gray Publication

Claims 1, 3-5, 7-25, 27, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Gray publication. The final Office Action states at page 3,

“Gray disclose a control information to a user equipment for changing the transaction mean of the user equipment based on a received control information based on a virtual transaction purchase by a user is begun on line including selecting the credit supplier. Upon receipt of the authorization form, the merchant completes the transaction/purchase and process that justified for the secure transaction, which may be processed by the card issuer as a card present,” citing to page 4, paragraphs 0034 and 0035.

Further, the final Office Action states at page 4,

“Gray discloses providing control information to the user equipment for updating or changing the user equipment’s transaction mean that the user equipment uses to conduct transaction with the merchant based on received control information based on a virtual transaction purchase by a user is begun on line including selecting the credit supplier. Upon receipt of the authorization form, the merchant completes the transaction/purchase and process that justified for the secure transaction, which may be processed by the card issuer as a card present with on line transaction an ability to modify parameters on line, and providing the user with better service,” citing to page 2, paragraph 0014 and page 4, paragraphs 0034 and 0035.

These statements are identically quoted in the Advisory Action without any further remarks to clarify or explain the reasonable basis for how each and every element as set forth in the claims is expressly or inherently described in the Gray Publication.

Applicant respectfully submits that the final Office Action and Advisory Action fail to establish a *prima facie* case for anticipation, including failing to establish that each and every element of the pending claims are disclosed by the Gray publication. As provided in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant submits that neither the final Office Action nor the Advisory Action provides a reasonable basis for how each and every element as set forth in the claims is expressly or inherently described in the Gray publication. MPEP § 2131 also expresses that “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant submits that the identical inventions that are claimed in the present application are not disclosed in the Gray publication, nor does the Gray publication teach a like invention disclosed in as complete detail as recited in the claims.

Applicant previously argued, and continues to submit, that the Gray publication fails to teach or disclose all of the claim limitations of the rejected claims. Specifically, Applicant previously argued, and continues to submit, that the Gray publication does not teach or suggest either (1) providing control information to a user equipment for changing the transaction means of the user equipment based on the

received control information or (2) providing control information to a user equipment for updating or changing the user equipment's transaction means that the user equipment uses to conduct a transaction with a merchant.

Applicant submits that the explanations of the final Office Action and citations therein do not support the rejections and, therefore, fail to support a *prima facie* § 102(e) rejection. For example, independent Claim 1 recites a first limitation of "receiving at the user equipment control information from a management entity independent of the merchant entity." Nothing in the rejections or the remarks in response to Applicant's arguments explains what data and/or transmission in the Gray publication discloses (or suggests) control information received *by* the user equipment *from* a management entity. And Applicant submits that nothing in the Gray publication teaches or suggests this claim limitation. Applicant respectfully submits that the rejection and remarks of the final Office Action in response to Applicant's arguments fail to clearly indicate what in the Gray publication corresponds to this claim limitation. For example, the remarks in the final Office Action are possibly best interpreted as indicating that the authorization form that is received is the control information. But, an authorization form in the Gray publication is transmitted from the Wallet server *to the merchant server*, not from the Wallet server *to the user equipment*. Further, the selection of a credit supplier is made by the user *to* the Wallet server. Alternatively, the remarks in the final Office Action may be interpreted as indicating that either or both of the citations to page 2, paragraph 0014 and page 4, paragraphs 0034 and 0035 correspond to this claim limitation. But those portions of the Gray publication merely reinforce Applicant's assertion that the Gray publication fails to disclose this claim limitation. For example, paragraph 0014 in the Gray publication states that "electronic transactions, such as purchase transactions, are conducted by receiving a transaction request *from* a user *at a wallet server*." This is exactly the opposite direction of transmission of the claim limitation. Similarly, paragraph 0034 in the Gray publication states that "the *wallet server 140 receives* transactional authentication, completes an authorization form for the transaction and transmits the form *to the merchant server 130*." In the Gray publication, the user of a browser Internet interface 110 transmits information to a merchant 130 and to a wallet server 140, and those two entities (i.e., the merchant 130 and wallet server 140) communicate to enable the user to complete the purchase transaction. By comparison, the claim limitation requires that the management entity transit control information *to the user equipment* so that the user equipment is compatible to conduct a transaction with a merchant. The Advisory Action provides no remarks to clarify or explain the rejections in response to these arguments.

Similarly, for example, independent Claim 1 recites a second limitation of "updating the transaction means based on the received control information to make it [i.e., the transaction means of the user equipment] compatible with said merchant entity after a change in the transaction mechanism

thereof.” Nothing in the rejections or the remarks in response to Applicant’s arguments explains what in the Gray publication discloses (or suggests) updating a transaction means of the user equipment. And Applicant submits that nothing in the Gray publication teaches or suggests this claim limitation. Applicant respectfully submits that the rejection and remarks in response to Applicant’s arguments fail to clearly indicate what in the Gray publication corresponds to this claim limitation. For example, the remarks in the final Office Action are possibly best interpreted as indicating that selecting the credit supplier is updating the transaction means. But the selection of a credit supplier is made by the user to the Waller server, not changing a transaction means of the user equipment based on received control information at the user equipment. Alternatively, the remarks in the final Office Action may be interpreted as indicating that either or both of the citations to page 2, paragraph 0014 and page 4, paragraphs 0034 and 0035 correspond to this claim limitation. But those portions of the Gray publication merely reinforce Applicant’s assertion that the Gray publication fails to disclose this claim limitation. Specifically, paragraph 0014 in the Gray publication states “an ability to modify parameters *on-line*.” Modifying parameters *on-line* is in contrast to the claimed limitation that *the transaction means of the user equipment* is updated, not, for example, information at an *on-line wallet server* or *on-line merchant entity*. And this cited disclosure of “an ability to modify parameters *on-line*” does not provide what parameters are modified and by what means with any particularity that could even be suggested of the claimed limitation. Similarly, paragraph 0034 in the Gray publication states that “*the wallet server 140 receives* transactional authentication, completes an authorization form for the transaction and transmits the form to *the merchant server 130*.” Nothing in the Gray publication updates a transaction means of the user equipment, which is merely a browser Internet interface. Applicant finds no disclosure in or suggestion from the Gray publication of any management entity providing a user equipment with any control information, and particularly not any control information for updating a transaction means of the user equipment to make the transaction means of the user equipment compatible with a merchant entity. And the Advisory Action provides no remarks to clarify or explain the rejections in response to these arguments.

In view of the remarks above, Applicant submits that the § 102(b) rejections of Claims 1, 5-24, and 26 are traversed. Applicant respectfully requests that the rejections be withdrawn and that the finality of the Office Action also be withdrawn with respect to this issue for lack of presentation of a *prima facie* § 102(b) rejection upon which finality of the pending Office Action may be supported.